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MAILED
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OFFICE OF PETITIONS

In re Patent of Nishimura et al.:
Patent No. 7,790,957 :
Issue Date: September 7, 2010 : DECISION ON
Application No. 10/566,593 : REQUEST FOR RECONSIDERATION
Filed: August 17, 2006 : OF
Atty Docket No. SHO-028US : PATENT TERM ADJUSTMENT

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION UNDER 37 CFR § 1.705(b)," filed October 27, 2010. The petition will be treated under 37 CFR 1.705(d). Patentees request the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by eight hundred seventy-one (871) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by eight hundred seventy-one (871) days is **GRANTED to the extent indicated herein.**

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

On September 7, 2010, the above-identified application matured into U.S. Patent No. 7,790,957 with a patent term adjustment of 751 days.

This request for reconsideration of patent term adjustment was timely filed within two months of the issue date of the patent. See 1.705(d). The Office acknowledges receipt of the \$200.00 fee set forth in 37 CFR 1.18(e).

As stated above, the patent issued with a revised Patent Term Adjustment of 751 days. The PTA of 787 days was reduced by 120 days pursuant to 37 C.F.R. § 1.704(c)(10) for the submission of a request for corrected filing receipt on March 25, 2010 after the mailing of the Notice of Allowance.

The reduction of 120 days is at issue. Patentees contend that applicants did not engage in behavior that reasonably would be considered as failing in efforts to conclude prosecution of the application by filing a request for corrected filing receipt on March 25, 2010.

The reduction has been considered and a reduction, albeit a different length of reduction, is warranted.

37 CFR § 1.704(c)(10) provides that:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four-months;

It is noted that a request for a corrected filing receipt is not listed among the papers filed after allowance that are not considered to be a failure to engage in reasonable efforts to conclude processing or examination of an application. See *Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed*, 1247 Off. Gaz. Pat. Office 111 (June 26, 2001) and MPEP 2732.

It is noted that on November 25, 2009, applicants requested that the filing receipt be corrected to list the correct spelling of the assignee's name. The Office failed to make the correction on the corrected filing receipt, mailed November 27, 2009. Applicants have not alleged non-receipt of the November 27, 2009 corrected filing receipt. Applicants should have submitted a subsequent request for corrected filing receipt promptly after receiving the November 27, 2009 corrected filing receipt. Applicant's waited several months to file a subsequent request to correct the assignee's name.

The period of reduction, per 37 CFR 1.704(c)(10)(i) is 5 days, beginning on March 25, 2010, the date the request for corrected filing receipt was filed, and ending on March 29, 2010, the mailing date of the corrected filing receipt. As such, a period of reduction of 5 days is being entered and the 120 day period of reduction is being removed.

The correct patent term adjustment is 866 days, which is the sum of 441 days of delay under 35 U.S.C. § 154(b)(1)(A) and 584 days of delay under 35 U.S.C. § 154(b)(1)(B), reduced by 159 days of Applicant delay.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

Nothing in this decision shall be construed as a waiver of the requirement of 35 U.S.C. 154(b)(4) that any civil action by an applicant dissatisfied with a determination made by the Director under 35 U.S.C. 154(b)(3) be filed in the United States District Court for the District of Columbia within 180 days after the grant of the patent.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **eight hundred sixty-six (866)** days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3230.



Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

CC: LAHIVE & COCKFIELD, LLP
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UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT : 7,790,957 B2

DATED : September 7, 2010

DRAFT

INVENTOR(S) : Nishimura et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 751 days

Delete the phrase "by 751 days" and insert – by 866 days--